

REMARKS

Claims 1-130 were pending in the application of which claims 1, 22, 37, 72, 85, and 99 were independent claims. No claims have been amended, added or canceled. Accordingly, claims 1-130 are still pending.

Claim Rejections Under §102(e):

Paragraph 3 of the Action rejects claims 1-12, 16-30, 32-46, 49-63, 65-72, 74-79, 81-87, 89-127, and 129 under 35 U.S.C. 102(e) as being anticipated by Wu et al. (U.S. Patent No. 6,813,489). Applicants respectfully traverses the rejection because Wu et al. fails to teach each and every limitation of claims 1-12, 16-30, 32-46, 49-63, 65-72, 74-79, 81-87, 89-127, and 129.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Certain embodiments of the present application are directed to a method for communicating whereby a client device generates and sends a data message to a mobile device. The mobile device receives the data message and displays the textual contents of the data message. Next, the mobile device causes a voice reply to the received data message to be generated when a reply is spoken into the mobile device using a transmit action. The voice reply is transmitted to a server that stores the reply and determines the destination address of the

intended recipient for the reply by referencing information previously stored on the server. The server then sends the recipient a message that notifies the intended recipient to retrieve a copy of the voice reply, or, alternatively sends a copy of the reply directly to the intended recipient as an attachment (See Applicants' Specification, paragraphs [0037], [0106]-[0112]).

In contrast with claim 1, Wu et al. fails to teach a “**client device transmitting the data message to a mobile device...the mobile device receiving the transmitted data message and displaying the textual content...the mobile device causing a voice reply to the received data message to be generated by speaking into the mobile device using a transmit action”** (See Applicants' Claims). Specifically, Wu et al. teaches a system whereby a user has to use his wireless device (i.e. mobile device) to logon to a **MAIL SERVER** to access his e-mail account (i.e. Yahoo mail account) and **RETRIEVE** his e-mail messages (i.e., data messages), which is completely different from the Applicants' claim 1 where data messages (e.g., e-mail) are sent directly to and received by the mobile device (See Wu et al., figure 1, column 4, lines 36-43 and column 5, lines 35-47). In short, Wu et al. fails to teach a mobile device that receives data messages, but instead, teaches a mobile device that retrieves data messages from a mail server.

Moreover, further in contrast with claim 1, Wu et al. fails to teach that a voice reply is generated simply by speaking into the mobile device using a transmit action (e.g., push-to-talk action). Specifically, Wu et al. teaches that the user has to terminate the data connection, initiate a call to an **EXTERNAL VOICE MESSAGING SYSTEM** and respond to “various prompts” before recording (i.e., generating) a voice reply (See Wu et al., column 4, line 66 to column 5, line 8; column 7, lines 6-17). That is, Wu et al. teaches that the voice reply is generated only after a number of different action steps (i.e., **MULTIPLE** transit action steps) and NOT a simple transmit action (e.g., push-to-talk action) where the user causes a voice reply to be generated by

a SINGULAR transmit action step (See Applicants' Specification, paragraph [0108]). Thus, the present invention as disclosed in claim 1 represents not only a different and improved messaging system compared to Wu, but one that makes it significantly easier for the mobile user to receive and reply to messages.

In contrast with claims 16 and 17, Wu et al. fails to teach that "the data message comprises an identifier," **the MOBILE DEVICE using the identifier to look up an e-mail address associated with the sender of the data message** (i.e., determining a reply path) then generating and sending an e-mail message containing the voice reply to the e-mail address. Instead, Wu et al. specifically teaches a **MOBILE SERVER SYSTEM** obtaining a "wireless device identifier" from the wireless device (See Wu et al., column 5, lines 9-11), mapping the wireless device identifier to the e-mail address of the sender of the data message (See Wu et al., figure 1, column 5, lines 13-15, column 6, lines 48-53) and a **VOICE SERVER SYSTEM** using the wireless device identifier to retrieve the e-mail address of the sender of the data message (i.e., determining a reply path) and recording and sending an e-mail message containing the voice reply to the sender (See Wu et al., column 7, lines 6-30). That is, the method taught in Wu et al. uses a **MOBILE SERVER** and a **VOICE SERVER** together with the wireless device identifier to determine a reply path for a voice reply NOT a **MOBILE DEVICE** (i.e., wireless device) using an identifier obtained from the sender data message to determine the reply path (See Wu et al., column 5, lines 9-20, column 6, lines 48-57). Simply, the method steps taught in Wu et al. are server side processes while the method steps in claims 16 and 17 are client side processes.

In contrast with claims 18-19, Wu et al. fails to teach a method wherein "...generating the voice reply comprises initiating a native voice call from the mobile device to **an intermediate address associated with a message authority**, and transmitting the spoken reply to

the message authority via the voice call" (claim 18) and "...the method further comprises, the message authority determining a destination address for the voice reply **by reference to the combination of the mobile device identifier and the intermediate address.**" (claim 19). Specifically, Wu et al. merely teaches a system in which only the mobile device identifier is mapped to a recipient address, NOT an intermediate address as recited in Applicants' claims 18 and 19 (See Wu et al., column 5, lines 9-20). Therefore, if there is more than one message or recipient address associated with the mobile device identifier, the Wu et al. system has no way of knowing which recipient address the mobile device user wishes to reply to without receiving further information from the mobile device user. As Wu et al clearly states: "If messages are pending the voice server system 25 retrieves the recipients' electronic addresses **and prompts the user to select which addresses should be associated with which voice message**" (See Wu et al., column 5, line 15-20). By mapping a different intermediate address to each recipient or message for the mobile device user, as recited in Applicants' claim 19, the combination of the mobile device identifier and the intermediate address can be used to determine the correct recipient address without further input by the mobile device user.

For at least the reasons stated above, the rejection should be withdrawn with respect to claims 1 and 16-19. Claims 2-12 and 16-21 depend directly or indirectly off of claim 1. Accordingly, claims 1-12 and 16-21 are in condition for allowance.

In contrast with claim 22, Wu et al. fails to teach a communication device comprising "a receiver configured to receive a data message, the data message comprising an identifier that can be used to determine a reply path associated with the received data message...a processor configured to parse the data message, extract the identifier, and determine the reply path from the identifier...a transmit action mechanism, the communication device configured to receive a

spoken reply to the data message in response to the initiation of a transmit action using the transmit action mechanism" (See Applicants' Claims). Specifically, Wu et al. fails to teach a communication device with a receiver configured to receive a data message. As discussed previously, Wu et al. teaches a system whereby a user has to utilize his wireless device (i.e. mobile device) to logon to a **MAIL SERVER** to access his e-mail account (i.e. Yahoo mail account) and **RETRIEVE** his e-mail messages (i.e., data messages) and, therefore, does not teach a receiver to receive a data message as recited in claim 22 (See Wu et al., figure 1, column 4, lines 36-43 and column 5, lines 35-47).

Furthermore, for the same reasons as those previously discussed, Wu et al. fails to teach communications device (i.e., **MOBILE DEVICE**) including "...a processor configured to parse the data message, extract the identifier, and determine the reply path from the identifier..." as Wu et al. teaches the use of a **MOBILE SERVER** and a **VOICE SERVER** together with the wireless device identifier to determine a reply path for a voice reply **NOT** a **MOBILE DEVICE** (i.e., wireless device) including a processor configured to parse the data message to extract an identifier used to determine the reply path (See Wu et al., column 5, lines 9-20, column 6, lines 48-57).

Moreover, for the same reasons as those discussed previously, Wu et al. additionally fails to teach "a transmit action mechanism, the communication device configured to receive a spoken reply to the data message in response to the initiation of a transmit action using the transmit action mechanism" as Wu et al. teaches that the voice reply is generated only after a number of different action steps (i.e., **MULTIPLE** transit action steps) and **NOT** a simple transmit action (e.g., push-to-talk action) where the user causes a voice reply to be generated by a **SINGULAR** transmit action step (See Wu et al., column 4, line 66 to column 5, line 8; column 7, lines 6-17).

In contrast with claims 23 and 24, Wu et al. fails to teach a message generator configured to “accept the spoken reply upon initiation of a transmit action, store the spoken reply as a voice message, create a data message, and attaché the stored voice message or a copy of the stored voice message to the data message” and comprising “a microphone and associated audio hardware configured to receive the spoken response from a user and convert the spoken response into a voice message for transmission using the transmitter” (See Applicants’ Claims). Specifically, Wu et al. teaches that the spoken reply is recorded using a **VOICE SERVER** in communications with the **MOBILE DEVICE** and **NOT** the **MOBILE DEVICE** itself (See Wu et al., column 7, lines 6-30). Simply, the mobile device disclosed in Wu et al. would have no need for the message generator recited in Applicants’ claims 23 and 24.

In contrast with claim 33, Wu et al. fails to teach a “memory coupled to the processor, and wherein determining the reply path associated with the data message comprises accessing the memory and looking up the reply path using the identifier” (See Applicants’ Claims). Specifically, as previously discussed, Wu et al. teaches the use of a **MOBILE SERVER** and a **VOICE SERVER** together with the wireless device identifier to determine a reply path for a voice reply **NOT** a **MOBILE DEVICE** (i.e., wireless device) with a processor element configured to parse a data message for an identifier and access a memory element configured to store a reply path associated with the identifier (See Wu et al., column 5, lines 9-20, column 6, lines 48-57).

In contrast with claims 34-36, Wu et al. does not teach the use of an intermediate address associated with the message authority, in combination with an identifier that can be used to identify the user of the communication device, to determine the final reply path.

For at least the reasons stated above, the rejection should be withdrawn with respect to claims 22-24 and 33-36. Claims 23-30 and 32-36 depend directly or indirectly off of claim 22. Accordingly, claims 22-30 and 32-36 are in condition for allowance.

In contrast with claim 37, Wu et al. fails to teach a communication system comprising a communication device including “a receiver configured to receive the forwarded data message...a processor configured to parse the received data message, extract the identifier from the parsed data message, and determine the reply path from the extracted identifier...a transmit action mechanism, the communication device configured to receive a spoken reply to the data message in response to the initiation of a transmit action using the transmit action mechanism” (See Applicants’ Claims). Specifically, for at least the same reasons as those discussed with relation to claim 22, Wu et al. fails to teach the receiver, processor and transmit action elements recited in claim 37.

In contrast with claims 38 and 39, Wu et al. fails to teach a message generator configured to “accept the spoken reply upon initiation of a transmit action, store the spoken reply as a voice message, create a data message, and attaché the stored voice message or a copy of the stored voice message to the data message” and comprising “a microphone and associated audio hardware configured to receive the spoken response from a user and convert the spoken response into a voice message for transmission using the transmitter” for at least the same reasons as those discussed with respect to claims 23 and 24.

In contrast with claim 43, Wu et al. fails to teach “the response comprises audible indicators” (See Applicant’s Claims). Specifically, Wu et al. is completely silent as to the voice server (i.e., collector) generating any audible indicators to indicate proper receipt of the spoken reply (See Wu et al., col. 8, line 45 – col.9, line 16.).

In contrast with claim 44, Wu et al. fails to teach that “the audible indicators comprise one or more audible beeps” (See Applicant’s Claims). Specifically, the references in Wu et al. to audible prompts are prompts notifying the mobile device user to **start speaking a reply**, whereas the “audible response” in the claims 42-44 are acknowledgements that the spoken reply **has been received by the message authority** (See Wu et al., column 10, line 61).

In contrast with claim 45, Wu et al. fails to teach a communication system “...wherein the collector comprises a plurality of receiving devices, wherein each of the plurality of receiving devices is associated with an address”. The citation simply recites that the Wu et al. system may comprise multiple servers, but does not state that they are analogous to the collector of claim 45, nor teach that there are multiple addresses associated with each (See Wu et al., column 3, line 47-col.4, line 8).

In contrast with claim 67, Wu et al. fails to teach that the communications device comprises a “memory coupled with the processor, and wherein determining the reply path associated comprises accessing the memory and looking up the reply path using the identifier” for at least the same reasons as those discussed with respect to claim 33.

For at least the reasons stated above, the rejection should be withdrawn with respect to claims 37-39, 43-45 and 67. Claims 38-46, 49-63 and 65-72 depend directly or indirectly off of claim 37. Accordingly, claims 37-46, 49-63 and 65-72 are in condition for allowance.

In contrast with claim 72, Wu et al. fails to teach “receiving a data message comprising an identifier that can be used to determine a reply path” and “in response to a transmit action, causing a voice reply to be created” for at least the same reasons as those discussed with respect to claims 1 and 22.

For at least the reasons stated above, the rejection should be withdrawn with respect to claim 72. Claims 74-79 and 81-84 depend directly or indirectly off of claim 72. Accordingly, claims 72, 74-79 and 81-84 are in condition for allowance.

In contrast with claim 85, Wu et al. fails to teach a communication device comprising “a receiver configured to receive a data message comprising an identifier that can be used to determine a reply path...a transmit action input, the communication device configured to cause a voice reply to the data message to be created in response to a transmit action initiated using the transmit action input” for at least the same reasons as those discussed with respect to claims 1 and 22.

For at least the reasons stated above, the rejection should be withdrawn with respect to claim 85. Claims 86-87 and 89-98 depend directly or indirectly off of claim 85. Accordingly, claims 85-87 and 89-98 are in condition for allowance.

In contrast with claim 99, Wu et al. fails to teach a communication system comprising a communication device including “a receiver configured to receive a data message comprising an identifier that can be used to determine a reply path...a transmit action input, the second communication device configured to cause a voice reply to the data message to be created in to the transmit action initiated using the transmit action input” for at least the same reasons as those discussed with respects to claims 1 and 22.

For at least the reasons stated above, the rejection should be withdrawn with respect to claim 99. Claims 100-127 and 129 depend directly or indirectly off of claim 99. Accordingly, claims 99-127 and 129 are in condition for allowance.

Claim Rejections Under §103(a):

Paragraph 61 of the Action rejects claims 13, 29, 47-48, 64, 80, 88 and 128 under 35 U.S.C. 103(a) as being unpatentable over Wu et al. in view of Guedalia et al. (U.S. Patent No. 6,907,112). Applicants respectfully request that this rejection be withdrawn because neither Wu et al. alone nor in combination with Guedalia et al. teaches all the elements of claims 13, 29, 47-48, 64, 80, 88 and 128.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Wu et al. alone or in combination with Guedalia et al., fail to teach or suggest each and every element of the claims.

Claims 13 depends directly off of independent claim 1, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is completely silent as to the mobile device receiving the transmitted data

message and causing a voice reply to be generated by speaking into the mobile device using a transmit action as recited in claim 1. Accordingly, claim 13 is in condition for allowance.

Claim 29 depends indirectly off of independent claim 22, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver, processor and transmit action elements recited in claim 22. Accordingly, claim 29 is in condition for allowance.

Claims 47-48 and 64 depend directly or indirectly off of independent claim 37, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver, processor and transmit action elements recited in claim 37. Accordingly, claim 47-48 and 64 are in condition for allowance.

Claim 80 depends directly off of independent claim 72, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is silent as to a mobile device receiving the transmitted data message and causing a voice reply to be created by using a transmit action as recited in claim 72. Accordingly, claim 80 is in condition for allowance.

Claim 88 depends indirectly off of independent claim 85, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver and transmit action elements as recited in claim 85. Accordingly, claim 88 is in condition for allowance.

Claim 128 depends indirectly off of independent claim 99, which for the same reasons as those discussed above is not anticipated by Wu et al. Guedalia et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver and transmit action elements recited in claim 99. Accordingly, claim 128 is in condition for allowance.

Paragraph 66 of the Action rejects claims 14-15, 31, 73 and 130 under 35 U.S.C. 103(a) as being unpatentable over Wu et al. in view of Everhart et al. (U.S. Patent No. 6,928,614). Applicants respectfully request that this rejection be withdrawn because neither Wu et al. alone nor in combination with Everhart et al. teaches all the elements of claims 14-15, 31, 73 and 130.

Claims 14-15 depend directly off of independent claim 1, which for the same reasons as those discussed above is not anticipated by Wu et al. Everhart et al. fails to cure the deficiencies of Wu et al. as it is silent to the mobile device receiving the transmitted data message and causing a voice reply to be generated by speaking into the mobile device using a transmit action as recited in claim 1. Accordingly, claims 14-15 are in condition for allowance.

Claim 31 depends directly off of independent claim 22, which for the same reasons as those discussed above is not anticipated by Wu et al. Everhart et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver, processor and transmit action elements recited in claim 22. Accordingly, claim 31 is in condition for allowance.

Claim 73 depends directly off of independent claim 72, which for the same reasons as those discussed above is not anticipated by Wu et al. Everhart et al. fails to cure the deficiencies of Wu et al. as it is silent as to a mobile device receiving the transmitted data message and causing a voice reply to be created by using a transmit action as recited in claim 72. Accordingly, claim 73 is in condition for allowance.

Claim 130 depends directly off of independent claim 99, which for the same reasons as those discussed above is not anticipated by Wu et al. Everhart et al. fails to cure the deficiencies of Wu et al. as it is silent as to the receiver and transmit action elements recited in claim 99. Accordingly, claim 130 is in condition for allowance.

CONCLUSION

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may be due with this response to deposit account 13-0480 referencing the attorney docket number listed above.

Respectfully submitted,

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